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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
NUTTER, NATHAN M	

ART UNIT	PAPER NUMBER
1796	

NOTIFICATION DATE	DELIVERY MODE
02/22/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/018,336	LETTMANN, BERNHARD	
	Examiner	Art Unit	
	Nathan M. Nutter	1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 February 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3,18,19,21,22,25,26,28 and 42-62* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3,18,19,21,22,25,26,28 and 42-62* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 3, 18, 19, 21, 22, 25, 26, 28 and 42-62 are now pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3, 18, 19, 21, 22, 25, 26, 28 and 42-62 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Examiner has re-read the Specification, and it is unclear what elements therein correspond to the claimed percents by weight of the constituents (a21), (a22) and (a23) at page 71 (line 5) to page 72 (line 18) in the Specification. It is pointed out to applicant that the Specification for (a23) the recitation of when “(a22) (is) from 1 to 30% by weight of at least one organic color pigment.” The parameter for inclusion of (a23) as "at least 20 to 89 % by weight water when" (a22) includes "1 to 70% by weight of at least one inorganic color pigment" is not shown at pages 75 and 76. The Specification does not teach the particular relationship of water and pigment as recited:

“(a22) 1 to 70% by weight of at least one inorganic color pigment or 1 to 30% by weight of at least one organic color pigment, optionally a combination of at least one organic color pigment and at least one inorganic color pigment ; and

(a23) 10 to 89% by weight water, except 20 to 89% by weight water when 1 to 70% by weight of at least one inorganic color pigment is present;"

The relationship now recited has not been shown to be in the Specification, as originally filed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 18, 19, 21, 22, 25, 26, 28 and 42-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al (US 6,403,701) taken in combination with Brock et al (US 5,672,649)

The instant invention is drawn to a process for preparing an aqueous coating material having desirable shade and optical effects, wherein said process comprises mixing of at least three components termed modules comprising: module (I) containing less than 5% by weight water, at least one binder, at least one pigment, and at least one organic solvent to form a base color (A1); module (II) comprising at least one aqueous color module comprising at least one water-soluble or -dispersible binder, at least one color pigment and water to form at least one aqueous color-imparting base color (A2); and module (III) comprising at least one pigment-free mixing varnish module (B)

comprising at least one aqueous, pigment-free varnish comprising water-soluble or-dispersible binder and water; and optionally at least one rheology control additive (C). Modules (I), (II) and (III) are stored separately and may be mixed before using. The nature of the binder(s) is not critical.

The reference to Reusmann et al teaches a mixing system for producing water-dilutable coatings which may have "precisely defined tinting from various base colors" and "with effect finishes" and "special-effect pigments." Note column 1 (lines 5-30). Reusmann et al teach the steps of: preparing a plurality of base colors; separately storing each of said base colors, and mixing, shortly before application of the coating composition. Note the Abstract, column 2 (line 61) to column 3 (lines 1 et seq.). The water-dilutable coating compositions may comprise a plurality of base colors (A) and at least one pigment-free component (B). The reference teaches the employment of at least one rheology-controlling additive. Note column 1 (lines 63-67). The base colors (A) comprise less than 5% by weight of water, at least one pigment, an organic solvent, and at least one water-dilutable first binder. The component (B) comprises a pigment-free an aqueous dispersion of polyurethane resin (second binder). Note claim 1. The component (A) is readable on the claimed (A-1) base color in the claimed module (I). The component (B) is readable on the claimed aqueous, pigment-free varnish module (III). The first binder (A) and the second binder in the component (B) can be the same binder. Note column 13 (lines 23-29) column 4 (lines 49-59) and column 9 (lines 7-16). The polyurethane resins can be prepared from an isocyanate-functional prepolymer at the paragraph bridging column 5 to column 6, and "the groups of component (c) which

are capable of forming anions are neutralized." Note column 7 (lines 14 et seq.). The water-dispersible polyurethane binder composition may contain polyacrylate, polyester and amino resins. Note column 11 (lines 18-26). The reference teaches the addition of a rheology-controlling agent, which embraces the optionally claimed component (C) at column 11 (lines 1-17). Suitable groups capable of forming anions include carboxyl groups. Note column 7 (lines 55-60). The coating composition is taught to comprise a plurality of base colors (A). The base colors (A) comprise a combination of at least one organic coloring pigment and at least one inorganic coloring pigment. Note column 12 (lines 56-59) and column 3 (lines 7-35). Suitable special-effect pigments can also be present at column 3 (lines 18-28). The solvents are water-soluble or water-thinnable solvents including alcohols. Note column 4 (lines 60-65). The reference discloses a process for preparing components (A) and (B), and directly after their preparation by mixing the component (A) and (B), the coating compositions may be applied to the substrate by spraying. Note column 13 (lines 43-56). The base colors compositions (A) can be mixed with a suitable amount of the aqueous component (B). Reusmann et al discloses a formulation of a water-dilutable coating composition, which can be diluted with water, with or without prior partial removal of the organic solvent employed in the preparing resin. Note column 11 (line 18) to column 12 (line 7) and column 13 (lines 7-17). The coating composition of Reusmann et al can include a plurality various of base colors (A), wherein "coloring pigments usually takes place by dispersing the respective pigments with one or more of the above-described binders." Note column 5 (lines 28-

32). The reference teaches the known use of special-effect pigments that may include metal flake, specifically aluminum, at column 3 (lines 7-29) and column 15 (lines 53-63).

The reference to Reusmann et al does not show the component (A2) as a separate module of an aqueous color module comprising pigment, binder and water. The reference does not show three modules as the mixing system. The reference does disclose a mixing system that may comprise many modules as used for coating compositions using a plurality of base colors (A) separately storing each of said base colors. Note column 15 (lines 48-67), column 16 (lines 1-10 and 65-67) and claim 1. Also, the reference shows the use of a component (A) that may contain from 20 to 80% by weight of at least one water-thinnable or water-dispersible binder. Note the paragraph column 12 (lines 22 et seq.).

The reference to Brock et al teaches the production and use of an aqueous coating system using modules. The reference teaches the employment of an aqueous module that comprises the system noted in the instant claims as (A2), comprising a colorant, a binder and water at column 2 (lines 17-24) and column 7 (line 34) to column 8 (line 10). The compositional limitations for the binder, pigment and water are shown at column 8 (lines 8-10) and clearly overlap with those recited herein. The use of anionic binders are taught at column 7 (lines 48-56). At the paragraph bridging column 6 to column 7, the reference teaches the employment of a lacquer system (herein, III). The reference clearly shows the modules designated as (A2) and (IV), since at column 3 (lines 56-61) the reference teaches the use of “a rheology module.” The reference

shows the use of aluminum flake special effect pigments as known at column 2 (lines 54-63).

Both references are drawn to aqueous coating mixer systems comprising modules. Since both are aqueous systems, the modules may be used from one in the other with a great expectation of success by the artisan having an ordinary skill in the art. Since the reference to Reusmann et al shows the modules for use, although the rheology module is not separate, but as an additive in other modules, as herein claimed, the use of a rheology module, as taught by Brock et al would have been a prima facie obvious step. Likewise, the use of the modular system (A2) as taught by Brock et al, in the mixer system of Reusmann et al would have been an obvious step. The references are drawn to identical systems that employ some differing modules. Both systems are aqueous-based systems. As such, inclusion of the modules taught by Brock et al for the many modules disclosed by Reusmann et al would have been a prima facie obvious modification. Nothing unexpected has been shown on the record.

Response to Arguments

Applicant's arguments filed 8 February 2010 have been fully considered but they are not persuasive.

With regard to the rejection of claims 3, 18, 19, 21, 22, 25, 26, 28 and 42-62 rejected under 35 U.S.C. 103(a) as being unpatentable over Reusmann et al (US 6,403,701) taken in combination with Brock et al (US 5,672,649), applicants have failed to show why the inclusion of the various modules, including the pigment and the

rheology module, would not be obvious to a skilled artisan since both references are drawn to multiple module systems, as herein claimed. The references both show the conventionality of the several elements, employed in identical capacities. The use of known elements, as disclosed, employed in known fashion, as disclosed, would be obvious, since the skilled artisan would have a high level of expectation of success to achieve the instantly claimed invention following the teachings of the references. Applicants have not demonstrated any clear reasoning or evidence as to why the use of the modules of Brock et al would be suitable in the system of Reusmann et al. The reference to Brock et al is relied upon for the reasons stated in the rejection. The instant claims require the same compositional limitations for the components as the references disclose, as pointed out. Since the components are shown to be known and conventional, the skilled artisan would enjoy success to achieve the instantly claimed invention following the teachings of the references, as pointed out in the rejection. Applicants assert the Examiner has "propos(ed) a 'mix and match' approach," which is not well-founded. The reference to Reusmann et al shows the rheology control additive at claims 1 and 5 of the reference. The requirement is only a binder, water and the control agent. The instant claims require an aqueous medium with the rheology control additive (instant claims 3, 18, 19, 21, 22, 25, 26, 28, 54, 55-58, 61 and 62), and this component is optional in the claims listed. Further, the claims recite "comprising," which fails to limit the claims to the specified constituents. The patent to Brock et al clearly shows the separate module, as pointed out in the rejection. Reusmann et al show a range of "from 0 to 10% by weight," at column 12 (lines 64-67). The limitations of claims

42 and 53 are easily envisaged. The rheology control additives of claim 56 are shown by Reusmann et al at column 11 (lines 1-17). Again, to use as a separate module would be obvious to an artisan, especially in view of Brock et al. Applicant's claims do not exclude other constituents in the module. Applicant has failed to show any difference. The binders of claim 54, being the same, are shown, as pointed out, by Reusmann et al at column 13 (lines 23-29). Applicant has failed to demonstrate or show any unexpected or surprising results in view of the teachings of the references, for the reasons stated. Further, it is pointed out that applicants' claims do not exclude the conjunctive use of the module (C) and the module (A) from Brock et al. The rejection above employs module (C), as pointed out, for the (A2) module herein. The use of the (C) module of Brock et al in the system of Reusmann et al would provide expected results. Since both references are drawn to modular paint systems, they are deemed to be analogous. Nothing unexpected has been shown on the record.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

nmn

14 February 2010